

REMARKS

Claims 1-11 of the present application stand rejected as obvious in view of applicants' admitted prior art in view of JP '799. The Official Action states that it is known that expanded polytetrafluoroethylene films are used as substrates for prepreg products. The present invention, as defined for example in claim 1, is a prepreg, comprising expanded porous polytetrafluoroethylene film having voids therein and flame-resistant resin composition disposed in said voids, wherein the bromine content of said resin is 0.09 weight % or less. JP '799 is cited by the Office for its disclosure of resin useful in the present invention.

Applicants cite JP '799 in the specification at page 4, line 31, as an example of a disclosure of a resin useful in the present invention. However, the fact that the resin is known does not render the present invention obvious. The Official Action provides no motivation for one skilled in the art to combine the references. Combining them as asserted in the Action is done only by means of hindsight, using applicants' disclosure against them.

The Federal Circuit spoke to this problem in In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999). The court stated that although "evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art or, in some cases, from the nature of the problem to be solved . . . [t]he range of sources available does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." In re Dembiczak, 50 USPQ2d at 1617 (emphasis added). The court went on to say that "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" Id. There has been no clear and particular showing of actual evidence for combining the art as asserted by the Office in rejecting the present claims. The combination is made only in the "tempting but forbidden zone of hindsight." Id., at 1616. As such, no *prima facie* case of obviousness has been, nor can be, established. Features of the prior art have been chosen and combined only with the benefit of applicants' disclosure, which is manifestly improper. Reconsideration is respectfully requested.

Should the Examiner in charge of this application have any questions regarding this response or the application generally, please contact applicants' undersigned attorney at the indicated telephone number.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Allan M. Wheatcraft". The signature is fluid and cursive, with the first name "Allan" being more prominent than the last name "Wheatcraft".

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